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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/397,503	09/17/1999	GAURAV AGGARWAL	Y0999-129	8826
7590	01/12/2004		EXAMINER	
McGINN & GIBB PLLC 8321 OLD COURTHOUSE RD., STE. 200 VIENNA,, VA 22182			ZIA, MOSSADEQ	
			ART UNIT	PAPER NUMBER
			2134	
			DATE MAILED: 01/12/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/397,503	AGGARWAL ET AL.
Examiner Mossadeq Zia	Art Unit 2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,3,4 and 7-38 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1,3,4, 7-38 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
  - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ . | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 19 is objected to because of the following informalities: this claim is dependent on claim 1, not claim 20 which the amended claim shows. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Regarding amended claim 1, the phrase "optionally encrypted" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

4. Claims 37, 38 recites the limitation " optional information" on page 10. There is insufficient antecedent basis for this limitation in the claim. The term should read "further information".

5. **Applicant's arguments**, see page 12 of amendment, with respect to claims 20, and 30 have been fully considered and are persuasive. The rejection of claims 20 and 30 has been withdrawn.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 2134

1. Claims 1, 2, 25 rejected under 35 U.S.C. 102(b) as anticipated by Patent No. 5,434,917

Naccache et al. The claim rejections are re-listed from original office action to address the amended claim 1.

2. In regards to claim 1, Naccache discloses a method of guaranteeing authenticity of an object (see fig. 2:14) comprising: providing a random sample (see col. 1, lines 34-42), associating a reproducible number that is obtained by a reader reading sample (see fig. 2:23) then forming a coded version of number, and recording the number into the object (see abstract and col. 1, lines 47-55).

3. In regards to claim 2, Naccache discloses the use of objects including smart card with method where the number associating to sample, which is essentially reproducible, is recorded onto object. Naccache further discloses the usage of a chip with recording support on the object (abstract and fig. 2:13).

4. In regards to claim 25, Naccache discloses a coded version of number includes one of optional data appended to it (see col. 3, lines 1-10).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patent No. 5,434,917, Naccache et al. in view of Patent No. 5,974,150, Kaish et al.

Art Unit: 2134

7. Naccache Regarding claim 37, Naccache discloses claim 1 above, but fails to disclose said optional information comprises the date of issue of said object.

However, Kaish shows that each authentication certificate (object) also includes other features (optional information) such as trademark, product identification, copyright text (date) (Kaish, col. 22, line 31-33).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Naccache as per teaching of Kaish to include these features to provide aid in obtaining a legal remedy in the case of simply copying said object (Kaish, col. 22, line 34-35).

8. Regarding claim 38, Naccache discloses claim 1 above, but fails to disclose said optional information comprises the functionality of an application of said object.

However, Kaish shows that each authentication certificate (object) also includes other features (optional information) such as trademark, product identification (functionality), copyright text (Kaish, col. 22, line 31-33).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Naccache as per teaching of Kaish to include these features to provide aid in obtaining a legal remedy in the case of simply copying said object (Kaish, col. 22, line 34-35).

#### *Response to Amendment*

9. **Applicant's arguments filed** on page 13, line 6-12, have been fully considered but they are not persuasive. Naccache clearly shows “said number (ID) being optionally encrypted in combination with further information (password)” (Naccache, col. 3, lines 1-10).

10. Applicant's arguments filed on page 13, line 18-20, have been fully considered but they are not persuasive. Applicant states, “The fibers of Kaish may have the characteristic that a

precise reading is not possible, but the steel marbles of Naccache would not share this characteristic.”

This examiner respectfully disagrees. Naccache reader is reading from an analog system and converting the reading to digital information thus can be considered essentially reproducible reading due to imprecise nature of converting analog data into digital data. Hence the examiners rejection for claims 1-36 stands.

***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mossadeq Zia whose telephone number is 703-305-8425. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Morse can be reached on 703-308-4789. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-3900.

Mossadeq Zia  
Examiner  
Art Unit 2134

mz  
12/30/03

*Greg O Morse*  
GREGORY MORSE  
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